

REMARKS

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action provided.

Applicants acknowledge with appreciation the indication that claims 4-7, 10, 11, 24 and 28 are allowable on page 5 of the Official Action.

Upon entry of the above amendments, claim 9 will have been canceled without prejudice or disclaimer of the subject matter thereof. Claims 4-8 and 10-29 are currently pending. Claims 12-23, 25-27 and 29 have been withdrawn by the Examiner. Applicants respectfully request reconsideration of the outstanding rejections, and allowance of all the claims pending in the present application.

On pages 4 and 5 of the Official Action, claim 9 was rejected under 35 U.S.C. § 103(a). Applicants note that claim 9 has been canceled by the present amendment, without prejudice or disclaimer of the subject matter thereof. Therefore this rejection is deemed to be moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a).

On pages 3 and 4 of the Official Action, claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over KANAI et al. (U.S. Patent No. 5,668,674) in view of Japan 10-39121 (hereinafter the Japanese document).

Applicants respectfully traverse the rejection of claim 8 under 35 U.S.C. § 103(a).

Applicants submit that the subject matter of claim 8 would not have been obvious to one of ordinary skill in the art, and particularly not in view of the teachings of KANAI et al. and the Japanese document. Applicants further submit that the modifications suggested by the Examiner are clearly the result of impermissible hindsight reasoning based upon the disclosure of the present application, rather than the teachings of the references themselves.

Claim 8 includes, inter alia, "A surveying instrument comprising: a sighting telescope".

Applicants initially note that the disclosure of KANAI et al. is directed to a finder system of a camera (note column 1, lines 5-15), rather than a *surveying instrument having a sighting telescope*. Accordingly, Applicants submit that KANAI et al. lacks any disclosure of a *surveying instrument having a sighting telescope*. Further, Applicants note that the Examiner has provided no statement as to motivation or obviousness with regard to such features of claim 8. Applicants further submit that the teachings of the Japanese document do not cure such deficiencies in the teachings of KANAI et al. Accordingly, Applicants submit that the subject matter of claim 8 would not have been obvious to one of ordinary skill in the art for at least this reason.

Claim 8 further includes, inter alia, "wherein said light shield device is formed by an extended portion of said erecting optical system on said incident surface thereof, said extended portion on said incident surface being deformed to extend toward said objective lens side so that said off-field light bundle which is reflected by a first reflection surface of said erecting optical system is prevented from being incident on a second reflection surface of said erecting optical system and being allowed to exit from said erecting optical system via said extended portion."

Applicants submit that KANAI et al. lacks any disclosure of an extended portion on *an incident surface, extending toward the objective lens*. In this regard, Applicants note that the extension 13d disclosed in KANAI et al. is clearly located at the exit surface of the erecting optical system, rather than on the *incident surface*.

Applicants further submit that the extension 13d in KANAI et al. (which is located at the exit surface) clearly does not *prevent a light bundle (which has been reflected by a first reflection surface of the erecting optical system) from being incident on a second reflection surface of the erecting optical system*. In this regard, Applicants note that the extension 13d in KANAI et al., which is located at the exit surface of the erecting optical system, clearly does not prevent a light bundle from reaching a further "reflection surface" (i.e., since there is no "reflection surface" in the erecting optical system after the extension 13d). Compare, for example, to Figs. 17 and 18 of the present application.

Applicants further submit that the teaching of the Japanese document would not have motivated one of ordinary skill in the art to provide the extension 13d in KANAI et al. on an incident surface instead of the exit surface of the erecting optical system. In this regard, Applicants submit that the system disclosed in the Japanese document, which uses *painted surfaces* for light shielding, is non-analogous to the system of KANAI et al., which uses an *extension* 13d. Further, Applicants submit that the modification suggested by the Examiner (i.e., providing an extension on an incident surface rather than on an exit surface) would effectively destroy the teachings of KANAI et al. itself, which is clearly directed to the benefits of providing a ghost preventing element *on an exit surface*. In this regard, Applicants note that KANAI et al. itself emphasizes the benefits of providing a ghost preventing element *on an exit surface* in order to prevent ghost light G from being incident on an eyepiece, as shown in Figs. 5 and 7 (note, for example, column 1, lines 56-58, 64, 65, and column 3, lines 40-52, 62-64). Accordingly, Applicants submit that KANAI et al. clearly teaches away from the modification suggested by the Examiner (i.e. providing an extension on an incident surface rather than on an exit surface).

However, even assuming, arguendo, that one would have been motivated to provide an extension on an incident surface in the system of KANAI et al., Applicants submit that such a modified system would still not include all of the features recited in claim 8, as explained below.

In regard to the disclosure of the Japanese document itself, Applicants submit that the Japanese document lacks any disclosure of an extended portion on an incident surface which *prevents a light bundle, which is reflected by a first reflection surface, from being incident on a second reflection surface*, much less such *a light bundle, which is reflected by a first reflection surface, being allowed to exit from the erecting optical system via such extended portion*. In this regard, the Examiner's attention is direct to, for example, the light bundle depicted in Figs. 17 and 18 of the present application, which is reflected off of surface 13b, and then exits from the erecting optical system via the extended portion. Accordingly, Applicants submit that the Japanese document can not possibly be characterized as providing any teaching of an extended portion on an incident surface which *prevents a light bundle, which is reflected by a first reflection surface, from being incident on a second reflection surface*, much less such *a light bundle, which is reflected by a first reflection surface, being allowed to exit from the erecting optical system via such extended portion*. Accordingly, Applicants submit that the teachings of the Japanese document clearly do not cure such deficiencies in the teachings of KANAI et al.

As explained in detail above, Applicants submit that KANAI et al. lacks several features recited in claim 8. As further explained in detail above, Applicants submit and that the Japanese document also lacks any teaching of such recited features, and thus can not possibly be relied upon for the provision of such features in the system of KANAI et al.

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Such missing features include, but are not limited to, the following:

- a surveying instrument including a sighting telescope;
- an extended portion on an incident surface;
- the extended portion preventing an off-field light bundle, which is reflected by a first reflection surface, from being incident on a second reflection surface; and
- the extended portion allowing an off-field light bundle, which is reflected by a first reflection surface, to exit via the extended portion.

Applicants respectfully submit that the rejection of claim 8 under 35 U.S.C. § 103(a) is improper at least for each and certainly for all of the above-noted reasons. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection, and an early indication of the allowance of this claim.

SUMMARY AND CONCLUSION


Entry and consideration of the present amendment, reconsideration of the outstanding Official Action, and allowance of the present application and all of the claims therein are respectfully requested and now believed to be appropriate.

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so.

Any amendments to the claims that have been made in this amendment, which do not narrow the scope of the claims, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered cosmetic in nature, and to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should there be any questions or comments, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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